COPY

Office-Supreme Court
FILED
JAN 22 196
JOHN F. DAVIS, CL

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1964

No. [redacted] 37

CALMAR, INC.,
Petitioner,

vs.

COOK CHEMICAL COMPANY,
Respondent.

No. [redacted] 43

COLGATE-PALMOLIVE COMPANY,
Petitioner,

vs.

COOK CHEMICAL COMPANY,
Respondent.

ON PETITIONS FOR WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

ROBERT D. HOVEY
1816 Federal Reserve Bank Building
Kansas City, Missouri 64106

VERNON B. KASSEBAUM
1500 Home Savings Building
Kansas City, Missouri 64106
Attorneys for Respondent

Of Counsel:

HOVEY, SCHMIDT, JOHNSON & HOVEY
WATSON, ESS, MARSHALL & ENGGAS

INDEX

Opinions Below 2
Jurisdiction 2
Question Presented 2
Constitutional Provisions, Statutes and Rules Involved 3
Statement 3
Argument 8

I. The Standard of Invention Employed by the Eighth Circuit Was Either Correct or Too Favorable to the Petitioners 9

II. The Result Reached by Both Courts Below, Holding the Scoggin Patent Valid, Is an Entirely Proper One 13

The Factor of Commercial Success 18

Conclusion 20
Appendix to Respondent's Brief A1

Table of Cases

Crome & Company v. *The Vendo Company*, 299 F.2d 852 (8th Cir. 1962) 13

Cuno Engineering Corp. v. *Automatic Devices Corp.*, 314 U.S. 84, 90 (1941) 10, 12, 20

Diamond Rubber Co. v. *Consolidated Rubber Tire Co.*, 220 U.S. 428, 441 (1911) 7

Ditto, Inc. v. *Minnesota Mining & Mfg. Co.*, 336 F.2d 67, 69 (8th Cir. 1964) 17

Ezee Stone Cutter Mfg. Co. v. *Southwest Industrial Products*, 262 F.2d 183 (8th Cir. 1958) 16

Graham v. *Cockshutt Farm Equip., Inc.*, 256 F.2d 358 (5th Cir. 1958) 12

Great Atlantic and Pacific Tea Co. v. *Super-Market Equipment Corp.*, 340 U.S. 147, 152 (1950) 12, 20

Jeoffroy Mfg., Inc. v. *Graham*, 219 F.2d 511 (5th Cir. 1955), cert. den. 350 U.S. 826 (1955) 12
John Deere Company of Kansas City v. *Graham*, 333 F.2d 529 (8th Cir. 1964) 10, 11, 12, 20
Lincoln Engineering Co. of Illinois v. *Stewart-Warner Corp.*, 303 U.S. 545, 549 (1938) 10
Magnum Co. v. *Coty*, 262 U.S. 159, 163 (1923) 8
Mumm v. *Jacob E. Decker & Sons*, 301 U.S. 168 (1937) 16, 17
Selmix Dispensers, Inc. v. *Multiplex Faucet Co., Inc.*, 277 F.2d 884 (8th Cir. 1960) 10, 19
Special Equipment Co. v. *Coe*, 324 U.S. 370, 378 (1945) 17
Temco Elec. Motor Co. v. *Apco Mfg. Co.*, 275 U.S. 319 (1928) 19

MISCELLANEOUS

"An Analysis of Patent Litigation Statistics", Staff Report, Subcommittee on Patents, Trademarks and Copyrights, Senate Judiciary Committee, 86th Cong., 2d Sess. (1961) 13
Article I, Section 8, Clause 8, Constitution 3
63 Col. L.R. 306, 320 11
Sections 101 through 103 and 282 of the Patent Code of 1952, 35 U.S.C. §§ 101-103, 282 ..... 3, 20, A1
Supreme Court Rule 19 ..... 3, 8, 13, 20, 21, A1

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1964

No. 778

CALMAR, INC.,
Petitioner,

vs.

COOK CHEMICAL COMPANY,
Respondent.

No. 810

COLGATE-PALMOLIVE COMPANY,
Petitioner,

vs.

COOK CHEMICAL COMPANY,
Respondent.

ON PETITIONS FOR WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

This brief is filed on behalf of Cook Chemical Company, respondent, in opposition to the separate Petitions of Calmar, Inc. and Colgate-Palmolive Company for writs of certiorari to the United States Court of Appeals for the

Eighth Circuit to review a judgment against both petitioners. The court below affirmed the judgment of the District Court holding respondent's patent (Scoggin, No. 2,870,943) valid and infringed by a device manufactured by petitioner Calmar, Inc., and sold (in connection with the sale of liquid household insecticide products) by petitioner Colgate-Palmolive Company, which purchased the device from Calmar.

Petitioner Colgate-Palmolive Company has filed a short petition which adopts the Petition of Calmar, Inc. Colgate Petition, p. 3. Our further references herein to the Petition are to the Petition filed by Calmar, Inc.

OPINIONS BELOW

The opinion of the District Court, including the findings of fact (App. E of Petition), is reported at 220 F. Supp. 414. The opinion of the Court of Appeals for the Eighth Circuit (App. B of Petition), is reported at 336 F.2d 110.

JURISDICTION

The jurisdictional requisites are adequately stated in the Petition.

QUESTION PRESENTED

Whether the decisions below, in holding the patent involved to be valid, follow and employ the applicable statutory and constitutional standards of patentability.

CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

The applicable constitutional provision is Article I, Section 8, Clause 8, and the applicable statutes are Sections 101 through 103 and 282 of the Patent Code of 1952, 35 U.S.C. §§ 101-103, 282, all of which except § 282 are set out in Appendix A to the Petition. Rule 19 of the rules of this Court, 347 U.S. Appendix, 28 U.S.C.A. (Supp.) is also involved. Section 282 of the Patent Code and Supreme Court Rule 19 are set out in the Appendix hereto.

STATEMENT

The need for such a device as Scoggin's became apparent as soon as manufacturers of liquid household insecticides commenced to furnish a plastic sprayer as a giveaway item with each consumer package of their product. (R. 53, 339) In the case of Cook Chemical Company, that was in 1947. (R. 51) At that time, Cook purchased the sprayers (which are not themselves a patented device) from Calmar Company, a predecessor of Calmar, Inc. (R. 51, 331, 332) The sprayer, which was furnished mounted in a perforated cap fitting the bottle or can in which the insecticide was packaged, was intended for insertion by the consumer, after the purchase, in the insecticide container. (R. 299) After she took her purchase home, the housewife unscrewed and threw away the container cap, inserted the bottom portion of the sprayer (the dip tube) in the bottle or can, and screwed on the perforated substitute container cap in which the sprayer was mounted. (R. 299)

When the goods were displayed for sale, one sprayer unit[1] had to be associated with each individual bottle or can of product. This was accomplished by fastening a cardboard collar (or plastic clip) around the neck of the bottle, with an appropriate hole in the collar in which the sprayer unit was inserted, the sprayer thus being suspended at the side of the insecticide package. (R. 51, 52)

The merchandising technique of giving away a sprayer with each consumer package of liquid insecticide was successful. (R. 60, 61) It was nearly a competitive necessity, in view of the alternate aerosol packages which reach the consumer ready for spraying when a button on the top is pushed. (R. 323, 324)

For ten years, while Cook "hung the sprayer on the side", its sprayer supplier, Calmar Company (petitioner Calmar's predecessor), attempted to develop a package for liquid insecticides in which the sprayer was mounted inside the bottle—that is, a package in which the sprayer unit had been pre-inserted. (R. 322, 325, 333)

The most difficult obstacle in the way of developing a successful shipper-sprayer was the low viscosity of insecticides, and, of course, there are other liquid products besides insecticides which present a similar problem. (R. 60, 315) No leakproof shipper-sprayer was available for use with such products. (R. 315-316) The control of leakage was indispensable to the development of a successful shipper-sprayer because of the messy, unattractive appearance of the package after leakage had occurred. (R. 57) A general difficulty was that the entire sprayer apparatus was a giveaway item, which was mass-produced

1. The expression "sprayer unit" refers to a sprayer mounted in a perforated container cap.

by the millions. (R. 332, 445, 449, 453) Whatever was developed had to be very inexpensive. (R. 75, 76, 78)

In an effort to solve these problems, Calmar Company tried to develop a protective plastic "boot" which would be inserted in the bottle, with the sprayer inserted inside the "boot". (R. 78, 537) This approach was abandoned because it was too expensive and because of the messiness of the necessary removal of the "boot" by the consumer before the sprayer could be operated. (R. 78, 304, 305)

Prior to the Scoggin invention, Calmar Company developed a device which was thought to have a great deal of promise. In this device, called the S-25-LP,[2] the sprayer head could be rotated, and locked, while it was in the fully depressed position. (R. 56, 301) The S-25-LP, which was intended to permit integrated packaging, was submitted by Calmar Company to Cook and other insecticide manufacturers. (R. 56, 300) Cook tested it and rejected it as leaky. (R. 55, 56, 300) It was accepted, however, by S. C. Johnson and Sons, the manufacturer of *Raid* insecticides, and was used by that company until the infringing device became available from Calmar. (R. 56, 303) The S-25-LP was in fact so leaky as to be highly unsatisfactory, and it was the subject of repeated and bitter complaints by the Johnson Company during the period of that company's use of it. (R. 538-540, 303-305) When the Scoggin shipper-sprayer appeared on the market, Calmar was in "grievous difficulty" due to its "grievous, sad experience" with the S-25-LP. (R. 305)

Scoggin's invention made use of a plastic cap, sometimes called an overcap, fitted over the top of the final

---

2. LP stood for leakproof. The device was misnamed in this respect. (R. 75, 76, 540)

package, which overcap was of such height as to hold the sprayer head down in the fully depressed position. (R. 490, 491, col. 1, lines 40-47) The overcap was attached (screwed on) to a plastic collar located just above the perforation in the container cap where the sprayer was mounted. (R. 490, Fig. 3) The overcap featured a seal formed at the point of its contact with the collar, and when screwed down tight, the overcap did not quite come into contact with the perforated container cap beneath. (R. 98, 99, 519) Maintaining the overcap above, and out of contact with, the container cap permitted a tight seal to be effected on the collar. (R. 98, 99, 519) The overcap covered the sprayer head, thus protecting it from damage, and was fitted by the manufacturer of the sprayer unit to the collar on the sprayer with exactly the proper amount of torque. (R. 151, 152, 63) Thus, an insecticide manufacturer desiring to employ the Scoggin device could purchase mounted sprayers assembled with overcaps as one unit, and attach them, as one unit, to the can or bottle containing his product simply by screwing on the container cap, without in any way disturbing the seal of the Scoggin device. (R. 278, 279) This permitted the insecticide packaging to be accomplished by means of automatic machinery. (R. 316)

The court below in its opinion quoted respondent's expert in summary of Scoggin's contribution, as follows:

> " 'The first commercially successful, inexpensive integrated shipping closure pump unit which permitted automated assembly with a container of household insecticide or similar liquids to produce a practical, ready-to-use package which could be shipped without external leakage and which was so organized that the pump unit with its hold-down cap could be itself assembled and sealed and then later assembled and sealed on the container without breaking the first seal.' " 336 F.2d at 113, Pet. 7a.

The several important advantages of the use of the Scoggin device, as compared with hanging the sprayer on the side, are not reviewed here. (See R. 59, 60) They are adequately covered by both opinions below and are nearly self-evident. (336 F.2d 112, Pet. 6a-7a. 220 F. Supp. 416, Pet. 17a) And, of course, the success and desirability of the Scoggin device were recognized by petitioner Calmar, Inc., by its immediate development of the infringing[3] SS-40 shipper-sprayer, and by petitioner Colgate by its purchase and use of that device. (336 F.2d 114, Pet. 9a-10a)

In its limited field, the Scoggin device answered a problem which had been manifest, both to the Calmar Company and to manufacturers of insecticides (and of other products of similarly low viscosity) for a decade, but as to which no solution had been discovered. That Scoggin answered the problem was shown not only by Calmar's copying but also by the fact that Cook received not over one hundred complaints on the sale of fifteen million units. (R. 67)

---

3. Infringement of the Scoggin patent by the SS-40 shipper-sprayer was a hotly contested issue in both courts below. Petitioners have finally abandoned that struggle; they tender no issue here as to infringement. The court below said that "Exercising our appellate prerogative in a patent case to interpret the exhibits for ourselves, we are constrained to agree with the trial court's statement that 'upon close inspection of the devices it is difficult to see how they could be much more similar and yet have any different features'." 336 F.2d at 114, Pet. 10a. Both courts thus found imitation to the point of substantial identity of the patented and infringing devices. Petitioners' sincerity in disparaging the Scoggin invention as "an episode in the puppet theatre of gadgetry" involving "trivial subject matter" (Pet. 17) is betrayed by their conduct in marketing and using such a "tinker's rearrangement". (Pet. 18) Although petitioners give the tribute of their praise to the prior art, it is no longer denied that they give Scoggin the tribute of their imitation. *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428, 441 (1911).

ARGUMENT

A great deal of petitioners' argument appears to us simply to attack this Court's exercise of its certiorari jurisdiction on the basis of general considerations which apply to the review of decisions by the courts of appeal generally. These considerations are not confined, either to patent cases as a class, or to such patent cases as involve the standard or test of invention. They do not focus on *the present case* at all.

This Court has repeatedly held that certiorari may not be used by a defeated litigant merely for the purpose of securing a second appellate review of his case. See, as one example among a multitude, *Magnum Co.* v. *Coty*, 262 U.S. 159, 163 (1923). The governing considerations as to the exercise of certiorari jurisdiction are set out affirmatively in Rule 19 of the Rules of this Court.

Paragraph 1 of Rule 19 states that certiorari will be granted, in the exercise "of sound judicial discretion, only where there are special and important reasons therefor". More specifically, Rule 19-1(b) states (without limitation) that decisions of the courts of appeal may be reviewed on certiorari—

> "(b) Where a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter; or has decided an important state or territorial question in a way in conflict with applicable state or territorial law; or has decided an important question of federal law which has not been, but should be, settled by this court; or has decided a federal question in a way in conflict with applicable decisions of this court; or has so far departed from the accepted and usual course of ju-

> dicial proceedings, or so far sanctioned such a departure by a lower court, as to call for an exercise of this court's power of supervision."

Convinced that this Court means to uphold its long-established limitations on review on certiorari, respondent sees no need to defend them against a general attack. Neither do we discuss the question whether this Court might properly have granted certiorari in the other patent cases, apparently a "parade of horribles", which are cited in the Petition at page 11, note 13, nor have we investigated whether petitioners have them properly cataloged. The only thing even remotely worth noting about these other decisions is that *not one* of them was rendered by the Eighth Circuit. We confine ourselves to the question whether *this case* presents any "special and important reasons" for review on certiorari.

I.

The Standard of Invention Employed by the Eighth Circuit Was Either Correct or Too Favorable to the Petitioners

Petitioners have given grudging approval to the test of invention or patentability as enunciated by the court below. See the first two sentences at the top of page 18 of the Petition. It should have received their unqualified approbation.

Scoggin is a mechanical combination patent, as the court below of course recognized. The court said that:

> "The issue of patentability of a new combination of old elements to form invention must, however, be approached keeping in mind the more exacting standard long required by the Supreme Court. In Selmix Dispensers, Inc. v. Multiplex Faucet Co., Inc., 277 F.2d 884 (8th Cir. 1960), we recognized the Supreme Court's

> admonition in Great Atlantic and Pacific Tea Co. v. Super-Market Equipment Corp., 340 U.S. 147, 152, 71 S. Ct. 127, 130, 95 L. Ed. 162 (1950) that 'The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable' ". 336 F.2d at 113, Pet. 7a.

There follows, at that point in the opinion below, citation of *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, 90 (1941) and *Lincoln Engineering Co. of Illinois* v. *Stewart-Warner Corp.*, 303 U.S. 545, 549 (1938), and of other recent Eighth Circuit cases, in addition to the *Selmix* case cited in the body of the quotation.

Selmix Dispensers, Inc. v. *Multiplex Faucet Co., Inc.*, 277 F.2d 884 (8th Cir. 1960), to which the principal reference was made in the present case by the court below, contains one of the Eighth Circuit's two[4] most extensive recent discussions of the standard of invention for combination patents. The *Selmix* opinion was written by Judge Van Oosterhout, who served as a member of the panel which decided the appeal in the present case. In view of the prominent reference in the opinion of the court below to *Selmix*, the fuller discussion of the standard of patentability in that opinion (pp. 886-7) is equally applicable in the present case.

Petitioners assert that there has been confusion among the various courts of appeal concerning the standard of invention during the last fourteen years. (Pet. 9, 10) We make the obvious reply that the principal cause of such confusion has been a diversity of view as to whether the 1952 Patent Code was, or was not, intended to lower the

---

4. The other is *John Deere Company of Kansas City* v. *Graham*, 333 F.2d 529 (8th Cir. 1964), petition for certiorari pending, discussed hereafter.

standard theretofore applied. See Comment, *The Standard of Patentability—Judicial Interpretation of Section 103 of the Patent Act,* 63 Col. L.R. 306 (1963). Among others of the courts of appeal, however, the Eighth Circuit has consistently taken a negative view, and held that the 1952 Patent Code did *not* lower the pre-existing standard. In the Columbia Law Review comment, *supra,* the author, after reviewing the applicable Eighth Circuit decisions, including *Selmix,* concludes as follows:

> "The foregoing cases make it clear that the Eighth Circuit does not treat section 103 as having established a standard of patentability more lenient than that applied immediately prior to the act. In fact, the court has displayed a strong inclination to avoid extensive discussion of section 103 and to determine patentability solely by reference to previous judicial pronouncements." 63 Col. L.R. 306, 320.

The Columbia Law Review comment was written before the Eighth Circuit decisions in *John Deere Company of Kansas City* v. *Graham,* 333 F.2d 529 (8th Cir. 1964), certiorari pending, and in the present case were rendered, and consequently they were not cited. Both fully support the author's conclusion, quoted above, which was reached on the basis of the earlier cases cited in the comment.

The *John Deere* case is a particularly vivid illustration of the strict Eighth Circuit attitude because of the conflict of that decision with two decisions of the Fifth Circuit. The patent in question (Graham, 2,627,798)—a mechanical combination—had been held valid by the District Court, 216 F. Supp. 272 (W.D. Mo. 1963). Two earlier decisions of the United States Court of Appeals for the Fifth Circuit concerning the same patent had held it

valid.[5] The Eighth Circuit reversed the District Court and held the patent invalid for want of invention. Among other things, the Court of Appeals there said

> "This court has adhered to the position that since *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, 62 S. Ct. 37, 86 L. Ed. 58 (1941), 'the amount of originality and ingenuity, over and beyond novelty and utility, which will constitute invention necessary to sustain a patent for a combination of old elements [such as we have here] in a crowded art, has increased'." 333 F.2d at 531.

While this Court may eventually decide to settle the conflict among the several circuits as to whether the 1952 Patent Code embodies a reduced substantive standard of invention (and, if so, any further question as to whether the applicable statutory provisions as so construed are valid), the present case involves no such question. The Eighth Circuit maintains the former test of invention, as set forth in this Court's landmark decisions, including *Great Atlantic and Pacific Tea Co.* v. *Super-Market Equipment Corp.*, 340 U.S. 147, 152 (1950) and *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, 90 (1941) in all its pre-1952 fullness and vigor, *and that is the test which was employed in this case.* If the respondent was entitled to the benefit of a more liberal test, it was deprived of that benefit here. No question along this line is open to petitioners in the present case—they contend "that Congress in enacting the 1952 Patent Code did not mean to lower the substantive standard of invention applied in the decisions of this Court". (Pet. p. 10, n. 10.)

---

5. *Jeoffroy Mfg., Inc.* v. *Graham*, 219 F.2d 511 (5th Cir. 1955), cert. den. 350 U.S. 826 (1955); *Graham* v. *Cockshutt Farm Equip., Inc.*, 256 F.2d 358 (5th Cir. 1958).

The Eighth Circuit has consistently so held, and so held in the present case.[6]

II.

The Result Reached by Both Courts Below, Holding the Scoggin Patent Valid, Is an Entirely Proper One

Petitioners' basic claim seems to be intended by them to be responsive to the last portion of this court's Rule 19-1(b), *supra*—that the Court of Appeals has, in the language of the rule,

> ". . . so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court as to call for an exercise of this court's power of supervision."

The whole pitch of the Petition is that the result reached here, both by the District Court and by the court below, is a gross miscarriage of justice. One example of the unrestrained language which appears throughout the Petition in this respect is the statement that this is "an

---

6. Petitioners have cited (three times) "An Analysis of Patent Litigation Statistics", Staff Report, Subcommittee on Patents, Trademarks and Copyrights, Senate Judiciary Committee, 86th Cong., 2d Sess. (1961). (Pet. ns. 7, 9 and 11) We wish to point out that Table 20 on pp. 24 and 25 of the "Analysis" shows that the various courts of appeals during the ten years 1949 through 1958 held 140 patents valid and infringed and 400 patents invalid whereas, during the same years, the Eighth Circuit held three patents valid and infringed and 23 patents invalid. The overall ratio is nearly 3:1 against validity. The Eighth Circuit's separate ratio is nearly 8:1 against. That is the crucial comparison, if these statistics have any relation whatever to this case. One of the Circuit Judges recently remarked that "Mechanical combination patents in this court have met with little recent success". *Crome & Company* v. *The Vendo Company*, 299 F.2d 852 (8th Cir. 1962) (dissenting opinion). The statistics certainly bear out his remark.

extreme case which vividly illustrates the recurrent abuse and debasement of the constitutional standard of patentability.'"[7] (Pet. 2)

Of course, an overall attack like petitioners' can be answered only on an overall basis. This case was thoroughly tried before an experienced District Judge, with expert testimony on each side. His findings and opinion speak for themselves. He commenced with a review of the problem of developing an integrated shipper-sprayer, then made a detailed analysis of claims 1 and 2 of the Scoggin patent, and followed with his understanding of the Scoggin structure. He noted our opponents' contention that the Scoggin claims here involved "lack invention, and that every element of the claims in suit is disclosed in the prior art, and that every combination or sub-combination recited in the claims can be found in the prior art". 220 F. Supp. at 418, Pet. 22a.

The District Court's statement of the issue as to validity, and his comments as to whether *"invention"*, as opposed to mere *"mechanical skill"*, was required to combine the old and known elements, as Scoggin did, warrants quotation in full here.

> "Therefore, the question is—was the combination of the admittedly old and known elements employed by Scoggin in accomplishing the result which he set out to achieve, invention or was it merely the result of mechanical skill?
>
> At first glance the mere simplicity of the idea would seem to present a very close question, but it must be remembered that we are dealing with a situ-

---

7. The Petition abounds in other similarly strong statements made in the course of the argument—it should be noted, however, that our quotation is taken from petitioners' statement of the questions presented, not from their argument.

ation that had long given trouble to those who were engaged in that business, and who were familiar with the problem and art.

The manufacturers of sprayers had not been able to solve the problem of leakage and breakage in the shipment of the products with which their spray pumps were used. Numerous ideas had been suggested by Calmar, the experiments were made, but none of them solved the problem. These facts and circumstances certainly must lead us to seriously doubt that it was so simple a mechanical problem as it seems now that it has been solved. However, simplicity and obviousness after the event do not negative invention. Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, and cases cited in note 4, p. 279, 64 S. Ct. 593, p. 595, 88 L. Ed. 721.

Now that it has been solved, one trained in mechanics and in the art might say, 'Well, that was a very simple problem and should easily have been solved', but the fact that many people were thinking about and working on it, and were unable to come up with the answer, raises it above the principle of mere simplicity. Hindsight is generally 20-20." 220 F. Supp. at 419, Pet. 23a.

On the appeal from the District Court's judgment, the court below thoroughly reviewed the findings and the evidence, in the light of petitioners' contentions. Here again, the nature of that court's consideration must speak for itself. But we wish to quote the passage in the opinion below, in which the Court of Appeals, after an analysis of the prior art, including all of that which is cited in the Petition, poses the essential question as to validity and answers it.

"Factual comparison of the individual elements of the Cook-Bakan 2 sprayer unit with prior art would permit a finding that its components are not novel

per se—threaded over-cap depressing sprayer head (Lohse Pat. No. 2,119,884); complementary threaded collar (Lohse Pat. No. 2,119,884; Darley Pat. No. 1,447,712); space tolerance between over-cap and container cap (Slade Pat. No. 2,844,290; Livingston Pat. No. 2,715,480); and shoulder-rib seal at zone beneath sprayer head and above threads (Mellon Pat. No. 2,586,687). *However, there is nothing in the prior art suggesting Scoggin's unique combination of these old features in such an assemblage as would solve the production, shipping and operation problems which for years beset the insecticide industry as well as producers of other low viscous liquids.* The patentee's 'closure assembly' eliminated the costly and time consuming steps in production requiring attachment of the sprayer holder to the outside of the container and insertion of the sprayer, while at the same time providing a protected, sealed sprayer unit which need only be screwed onto the top of the insecticide container like a metal cap, not to be disturbed until removal of the over-cap and application by the ultimate consumer. *This novel 'marriage' of the sprayer with the insecticide container which took years in the discovery is neither taught by, nor readily discernible from the application of mechanical skill to the elements of the prior art."* 336 F.2d at 113, Pet. 8a. (Emphasis supplied)

One factor that is not mentioned at all in the Petition should be noted—both the District Court and the court below properly held that petitioners had the burden of proof on the issue of validity. The District Court in the first instance cited this Court's decision in *Mumm* v. *Jacob E. Decker & Sons,* 301 U.S. 168 (1937), and the Eighth Circuit's decision in *Ezee Stone Cutter Mfg. Co.* v. *Southwest Industrial Products,* 262 F.2d 183 (8th Cir. 1958), as to the burden of proof, and quoted portions of both opinions. 220 F. Supp. at 420, headnotes 2 and 3, Pet. 25a. The court below, citing 35 U.S.C. Sec. 282,

simply stated that "The statute provides that a patent shall be presumed valid and the burden of establishing invalidity rests on the party asserting it", 336 F.2d at 113, Pet. 7a, thus quoting the exact language of the present statute. This Court said in *Mumm* that the burden of proving invalidity "is a heavy one, as it has been held that 'every reasonable doubt should be resolved against him'." 301 U.S. at 171.

In an opinion rendered a week after the opinion below, the Eighth Circuit quoted and approved an earlier statement of its rule on review of patent cases involving the test of invention, as follows:

> "When a trial court in a patent case has followed proper legal standards in determining the question of the presence or absence of patentable invention, its finding on that issue, if sustained by the evidence, will not be disturbed on appeal." *Ditto, Inc.* v. *Minnesota Mining & Mfg. Co.*, 336 F.2d 67, 69 (8th Cir., 1964).

The Circuit Court followed that rule here. Petitioners are asking this Court to review the identical record which the court below found sustained the District Court's ultimate finding of invention, without any showing of a misapprehension by either court as to the legal test of patentability.

To what is said in the Petition about the undesirability of extending patent monopolies beyond the point where they reflect invention, we reply in the words of this Court that "By the very terms of the statute, the grant is nothing more than a means of preventing others, except under a license from the patentee, from appropriating his invention". *Special Equipment Co.* v. *Coe*, 324 U.S. 370, 378 (1945). The *exclusive use* of the Scoggin invention from the time the patent was issued six years

ago would have given respondent an important advantage over competing manufacturers of household insecticides, including the corporate giant which is a petitioner here. Respondent was entitled to that advantage, provided, of course, that the patent is valid—that it does indeed embody "invention". The present lengthy litigation has explored every aspect of that question. During its pendency in the District Court and the Court of Appeals, respondent's right to exclude others from the Scoggin invention has been converted, over its vigorous objections, into a claim for damages so far as that critical period is concerned. At this stage, and with the case in this posture, the respondent is entitled to assert that it has been wronged by being denied the benefit of its lawful monopoly during roughly one-third of the total term of the patent.

The Factor of Commercial Success

As to the petitioners' more specific contention, that too much weight was given by the courts below to the factor of commercial success, we wish to point out that throughout this long litigation, petitioners have contended that the Scoggin device was so leaky as not to be satisfactory for its purpose—a contention which is repeated in the Petition. (p. 7, n. 4 and p. 19, n. 22) Naturally this called for evidence on respondent's part that the device manufactured under the patent was sufficiently perfect so as to be useful. The District Court found as a fact that the Scoggin device, after slight initial modifications, solved the leakage problem. 220 F. Supp. at 418 (third paragraph, second column) and 421 (headnote 5); Pet. 22a and 27a.

When the court below mentioned the evidence that respondent had sold fifteen million of the Bakan 2 shipper-sprayers and had received not over 100 complaints (336

F.2d at 113, 114, Pet. 9a) it spoke in terms of commercial success—but the evidence was vital on the issue of *utility*. In any case, petitioners' challenge of the utility of the Scoggin device necessarily resulted in the evidence referred to being given more prominence than it would have received if utility had not been a highly contested issue.

On the merits of this point, however, we wish to note that the District Court specifically said that commercial success might be taken into consideration in determining the question of invention, but that it was not necessarily determinative, citing this Court's decision in *Temco Elec. Motor Co.* v. *Apco Mfg. Co.*, 275 U.S. 319 (1928) and other authorities. 220 F. Supp. at 421, Pet. 26a, 27a. And the court below said that "Evidence of commercial success in a doubtful case may turn the scale in favor of the patentee". 336 F.2d at 114, Pet. 9a. For a recent case in which the Court of Appeals rejected an argument that the commercial success of a device established its patentability, see *Selmix Dispensers, Inc.*, v. *Multiplex Faucet Co., Inc.*, 277 F.2d 884 (8th Cir. 1960), at headnote 5 on page 887. (We have previously noted that the *Selmix* opinion was written by Judge Van Oosterhout, who served as a member of the panel on the court below in this case.)

It appears to the respondent that the evident and long-felt need for an integrated shipper-sprayer is a much more important factor bearing on the question of invention than is the commercial success of the Scoggin device. And we feel that a fair reader of both of the opinions below would agree that both the District Court and the Court of Appeals gave far more weight to this factor on the issue of invention than they did to the factor of commercial success, treated as such. As we have already pointed out, the success of the Scoggin device was considered, and it *must* be considered, in connection with the

other point—that is, whether the Scoggin device successfully answered the problem of providing a leakproof integrated shipper-sprayer.

CONCLUSION

We have shown that petitioners simply disregard this Court's basic limitations on the exercise of its certiorari jurisdiction, as set forth in Rule 19. Indeed, they devote a great part of the Petition to a direct attack on "the certiorari policy".

There is no conflict here between circuits as to the validity of the patent involved, such as is presented by *John Deere Company of Kansas City* v. *Graham*, 333 F.2d 529 (8th Cir. 1964), petition for certiorari pending, where the Eighth Circuit found lack of invention in a patent which the Fifth Circuit had twice previously sustained. And, further, there is no difference here between the District Court and the Court of Appeals, nor even a dissenting opinion in the court below.

The only important unsettled question of federal law in the area of the standard of patentability is whether the 1952 Patent Code (particularly, but not confined to, 35 U.S.C. Sec. 103) did, or did not, lower the pre-existing test of invention as enunciated in the prior decisions of this Court. This case does not present that question.

The court below applied in this case, and it follows generally, the (pre-1952 Patent Code) landmark decisions of this Court and particularly *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941) and *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950), as specifying the currently applicable statutory test of invention.

The patent involved here is, as the District Court said, for an invention "in a narrow art, one pertaining primarily to the sealing, shipping and use of insecticides by means of liquifying sprayers". 220 F. Supp. at 421, Pet. 27a. In itself, the patent certainly has no great public importance.

Both the findings and opinion of the District Court, and the opinion of the Court of Appeals, show that this case was thoroughly tried in the first instance, and that all of petitioners' contentions have been attentively reviewed below. These opinions themselves repel the petitioners' contention here that a gross miscarriage of justice has occurred in this case. The petitioners had the burden of proof and simply failed to carry it. Both courts reached the correct result.

In short, the Petition totally fails to set forth any "special and important reasons" whatever for the grant of certiorari here. In consequence, the Petition is nothing more than an at-large attack on this Court's certiorari policy, as expressed in its Rule 19.

The Petitions of Calmar, Inc., and Colgate-Palmolive Company for certiorari should be denied.

Respectfully submitted,

ROBERT D. HOVEY
1816 Federal Reserve Bank Building
Kansas City, Missouri 64106

VERNON B. KASSEBAUM
1500 Home Savings Building
Kansas City, Missouri 64106

Attorneys for Respondent

Of Counsel:

HOVEY, SCHMIDT, JOHNSON & HOVEY
WATSON, ESS, MARSHALL & ENGGAS

January 1965

APPENDIX TO RESPONDENT'S BRIEF

The first paragraph of Section 282 of the Patent Code of 1952, 35 U.S.C. Sec. 282, is as follows:

§282. Presumption of validity; defenses

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

* * *"

Rule 19 of the Rules of the Supreme Court of the United States, 347 U.S. Appendix, 28 U.S.C.A. (Supp.) reads as follows:

"19.

Considerations Governing Review on Certiorari

1. A review on writ of certiorari is not a matter of right, but of sound judicial discretion and will be granted only where there are special and important reasons therefor. The following, while neither controlling nor fully measuring the court's discretion, indicate the character of reasons which will be considered:

(a) Where a state court has decided a federal question of substance not theretofore determined by this court, or has decided it in a way probably not in accord with applicable decisions of this court.

(b) Where a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter; or has decided an important state or territorial question in a way in conflict with applicable state or territorial law; or has decided an important question of federal law which has not been, but should be, settled by this court; or

has decided a federal question in a way in conflict with applicable decisions of this court; or has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court, as to call for an exercise of this court's power of supervision.

2. The same general considerations outlined above will control in respect of petitions for writs of certiorari to review judgments of the Court of Claims, of the Court of Customs and Patent Appeals, or of any other court whose determinations are by law reviewable on writ of certiorari."